

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

REMARKS

Reexamination and reconsideration of this application as amended is requested. By this amendment, Claims 1, 5, 6, 9, and 28 have been amended. After this amendment, Claims 1-39 remain pending in this application.

Overview of the Present Invention

The present invention is a system and method for user-specified error correction in an instant messaging system. The invention utilizes at least **two client systems** that are communicatively coupled to a **"messaging server system"** via a network. Page 4, lines 13-15 of the instant application. Therefore, **there are at least three participating components** in the present invention. The messaging server system contains an instant message manager and **controls the flow of messages between the client systems**. Page 5, lines 1-3 of the instant application. Claims 1 and 28 have been amended to emphasize that there are three participating components and that the corrected message is sent to a messaging manager on the messaging server. Claims 5 and 6 have been amended to emphasize that the method is carried out by the message manager on the messaging server.

FIGs. 4-6 of the instant application show the operational flow of the present invention, where message corrections can be made at a transmitting client device and routed to the messaging server. The messaging server then determines whether or not the message has been transmitted to the receiving client and either corrects the message before sending or forwards the corrections to the receiving client device if the message has already been sent. See also the specification, Pages 7-12. Finally, the receiving client device checks to see if the message is a correction and, if it is, retrieves the original message from the

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

conversation log, corrects it, and alerts the user that a correction has been submitted.

(2) Claim Rejections - under 35 USC § 102 Svoboda

In item 2 on page 2 of the Office Action, the Examiner rejected Claims 1-9, 11, 13, 14, 28-36, 38, and 39 under 35 U.S.C. 102(e) as being anticipated by Svoboda (U.S. Patent No. 6,597,771).

Claims 1 and 28:

Applicant has amended Claims 1 and 28 to more clearly and distinctly recite the present invention. Support for this amendment may be found in the specification as originally filed, see for example page 4, lines 11-20 and FIG. 1. No new matter was added.

Before further discussing the Svoboda reference, it is believed that a brief review of amended claim 1 would be helpful. Claim 1 states, *inter alia*:

accepting a correction to a message previously **sent to a recipient device**;
determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification; and
based on the determination of message correction of the previously sent message, sending **to an instant message manager** on a messaging server one of a complete corrected message and a message correction specification.
(emphasis added)

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

Overview of the Svoboda Reference

The Svoboda reference teaches a method performed **directly** between **two** devices—a transmitter communication unit and a receiver communication unit. The focus of the Svoboda invention is on a password that contains information regarding the identity of a sender of a message and works “as a key for obtaining an access to functions of modification and/or deleting a message having been stored.” *See, for example*, claim 1 of Svoboda.

The transmission unit and receiver unit of Svoboda are coupled through a network, such as the internet. Svoboda, col. 2, lines 53-63. Each of the transmission unit and the receiver unit are “connected to a storage unit, e.g. a mail server.” Svoboda, col. 2, lines 56-57. Importantly, Svoboda does not discuss any purpose of the “mail server” other than as merely a storage space. Therefore, the mail server of Svoboda does not have functionality for message correction or replacement as does the novel routing server of the present invention. Svoboda states only that the password will grant access to the sender for modifying or deleting a message stored in the communication unit of the receiver. In short, **Svoboda does not teach or explain a messaging server or its functions as claimed for the present invention.**

The Examiner states that Svoboda anticipates claim 1 and cites, on pages 2 and 3 of the Office Action, col. 1, lines 57-67 of Svoboda. The cited portion of Svoboda states: “*after receiving a message, the message being delivered into a receiver communication unit through data communication means and stored in a storage unit, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message stored in a*

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

communication unit of the receiver. (emphasis added) All of the message editing functionality of Svoboda and all of the language quoted by the Examiner is describing functions performed in a storage area at the ***receiving*** client device. Claim 1 of Svoboda recites "a key for obtaining an access to functions of modification and/or deleting a message having been stored in the receiver ***communication unit.***" There is no message server and no functionality at a message server disclosed by Svoboda.

Claim 1 is written from the point of view of a sending device and has been amended to clarify that a message correction instruction is sent to an instant message manager on a message server that is separate from the sending device and the receiving device. Svoboda describes passwords and password access to the storage area on the receiving unit. There is no "determination of message correction" and there is no "sending to a message manager."

Because all of the functionality of Svoboda is performed at the receiving device, Svoboda is completely silent on "***determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification***" and then "***based on the determination of message correction of the previously sent message, sending to an instant messaging manager on a messaging server one of a complete corrected message and a message correction specification.***"

Claim 28 recites the same method steps as does claim 1. However, the method steps in claim 28 are in the form of instructions on a computer readable medium. As stated above, Svoboda discusses only functions occurring on the receiving client device. Therefore, Svoboda is completely silent on "a computer readable medium comprising computer instructions for determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification," which is a

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

step that occurs on a sending device and not a receiving device.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claims 1 and 28 (at least "*sending to an instant messaging manager on a messaging server*" and "*computer instructions for determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification*") of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1 or claim 28. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of the claims.

Claims 5 and 32:

Independent claim 5 recites, *inter alia*:

A method performed by an instant message manager on a messaging server, the method comprising
receiving a message correction specification and a message identifier (ID) from an originating client system; and
sending the message correction specification and the message ID to a recipient client system if a message with a corresponding message ID has previously been sent to the recipient client system.

Claim 5 recites a method performed by an instant message manager on a

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

messaging server, which is absent from Svoboda. Claim 32 of the instant application, recites the method steps being stored on a computer readable medium, which Svoboda is also silent on.

Claims 5 and 32 recite receiving a message from an originating client system and then checking a message ID before sending to a client system. This operation is a step that is performed on a device **between** the sending device and the receiving device.

Svoboda is completely silent on a message server or any other similar device and, as a result, silent on functionality within a device (such as a message server) located between the sending and receiving device. Therefore, **Svoboda does not disclose a server device** that checks whether "*a message with a corresponding message ID has previously been sent to the recipient client system*" before "*sending the message correction specification and the message ID to a recipient client system,*" as recited in claims 5 and 32 of the instant application.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claims 5 and 32 (at least "*receiving a message correction specification and ...sending the message correction specification...to a recipient client system if a message with a corresponding message ID has previously been sent...*") of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 5 or claim 32. Accordingly, the present invention distinguishes over Svoboda for at

contained in the ... claim."

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of the claims.

Claims 6 and 33:

With regard to independent claims 6 and 33 of the instant application, claims 6 and 33 recite, *inter alia*:

receiving a message correction specification and a message identifier (ID) **from an originating client system**;
correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent **to a recipient client system**; and
sending the corrected message and the message ID to a recipient client system. (emphasis added)

Claim 6 recites that the method is performed by an instant message manager on a messaging server, which is absent from Svoboda. Claim 33 of the instant application, recites the method steps being stored on a computer readable medium, which Svoboda is also silent on.

The Examiner, on pages 2 and 3 of the Office Action, cites col. 1, lines 57-67 of Svoboda, which states "*after receiving a message, the message being delivered into a receiver communication unit through data communication means and stored in a storage unit, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message stored in a communication unit of the receiver.*" (emphasis added) All of the message-editing functionality of Svoboda and all of the language quoted by the Examiner is describing functions performed at the *receiving* client device.

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

Svoboda is completely silent on any message editing operations prior to the message being delivered to the receiving client device. Therefore, Svoboda could not, and does not, disclose checking whether a message has *"previously been sent to a recipient client system"* and *"correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system."* Furthermore, because the message is already residing in a storage space at the receiving client device in Svoboda, Svoboda does not disclose the resulting step of *"sending the corrected message and the message ID to a recipient client system,"* as recited in claims 6 and 33.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claims 6 and 33 (at least *"sending the corrected message and the message ID to a recipient client system"*) of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 6 or claim 33. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of the claims.

Claims 9 and 36:

Independent claims 9 and 36 recite, *inter alia*:

- maintaining an ephemeral storage log of an instant messaging conversation;
- receiving a message correction specification and a message identifier (ID) from an originating client system;
- determining if a message processing service is required;
- correcting a message with a corresponding message ID in the ephemeral storage log if a message processing service is

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

required; and
sending the corrected message and the message ID to a
recipient client system.

Claim 9 recites that the method is performed by an instant message manager on a messaging server, which is absent from Svoboda. Claim 36 of the instant application, recites the method steps being stored on a computer readable medium, which Svoboda is also silent on.

As stated above, all of the message-editing functionality of Svoboda and all of the language quoted by the Examiner on pages 2 and 3 of the Office Action is describing functions performed at the *receiving* client device.

The steps recited in claims 9 and 36 describe correcting a message *prior* to sending it to the recipient client system. Therefore, Svoboda is completely silent on: *maintaining an ephemeral storage log of an instant messaging conversation; receiving a message correction specification and a message identifier (ID) from an originating client system; determining if a message processing service is required; and correcting a message with a corresponding message ID in the ephemeral storage log if a message processing service is required before sending the corrected message and the message ID to a recipient client system*, as recited in claims 9 and 36 of the instant application.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claims 9 and 36 of the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 9 or claim 36. Accordingly, the present invention distinguishes over

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

Svoboda for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of the claims.

Claims 11 and 38:

Independent claims 11 and 38 recite, *inter alia*:

- receiving a message correction specification and a message identifier (ID) from a messaging server;
- retrieving a message with a corresponding message ID from a conversation log;
- correcting the message;
- updating the conversation log; and
- activating an alert to notify a user of an update.

Svoboda discloses messages that are sent to a receiving client device and then deposited in a storage unit. Svoboda, col. 2, lines 50-62. The invention of Svoboda allows a user of the sending device to cause the message in the storage unit to be edited or deleted. Svoboda, col. 2, lines 24-31. Importantly, however, Svoboda is completely silent on "*activating an alert to notify a user of an update.*" In fact, Svoboda specifically states that the "invention allows the sender to change or delete the message **without bothering the addressee** with an invalid message." Svoboda, col. 2, lines 31-33. Therefore, Svoboda actually and expressly *teaches away* from "activating an alert to notify a user of an update," as recited in claims 11 and 38 of the instant application.

Additionally, Svoboda is silent on a "conversion log" and is therefore silent on the step of "*updating a conversion log,*" as recited in claims 11 and 38 of the instant application.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹ Because the elements in independent claims 11 and 38 of

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

the instant application are not taught or disclosed by Svoboda, the apparatus of Svoboda does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 11 or claim 38. Accordingly, the present invention distinguishes over Svoboda for at least this reason. The Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome. The Examiner should withdraw the rejection of the claims.

(3) Claim Rejections - 35 USC § 103 Svoboda

The Examiner rejected Claims 10 and 37 under 35 U.S.C. 103(a) as being unpatentable over Svoboda (U.S. Patent No. 6,597,771).

In the section entitled "Rejection under 35 U.S.C. § 102 Svoboda" above, the deficiencies of the prior-art system disclosed in the Svoboda reference were discussed. Claims 10 and 37 depend directly from claims 9 and 36, respectively. As discussed above, independent claims 9 and 36 distinguish over Svoboda. Further, in view of the discussion above, it should be clear that Svoboda does not teach, anticipate, or suggest, the presently claimed invention, as recited for claims 9 and 39. Since dependent claims contain all the limitations of the independent claims, claims 10 and 37 distinguish over Svoboda, as well.

Accordingly, the Applicant respectfully submits that the Svoboda reference does not teach, anticipate, or suggest, the presently claimed invention, as recited for dependent claims 10 and 37. The Applicant requests that the Examiner withdraw the rejection of claims 10 and 37.

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

(4) Claim Rejections - 35 USC § 103 Maurille in view of Svoboda and Golan

The Examiner rejected Claims 15 -27 under 35 U.S.C. 103(a) as being unpatentable over Maurille (U.S. Patent No. 6,484,196) in view of Svoboda (U.S. Patent No. 6,597,771) and further in view of Golan (U.S. Pub. No. 20020194278).

Before discussing the prior art in detail, it is believed that a brief review of the present invention would be helpful. Claim 15 recites, *inter alia*:

...
an error corrector, communicatively coupled to the instant messaging client, for accepting a correction to a previously sent message, determining whether a message correction of the previously sent message requires sending one of a complete corrected message and a message correction specification, and **based on the determination** of message correction of the previously sent message, **sending to a messaging server** one of a complete corrected message and a message correction specification. **(Emphasis added).**

Claim 15 recites "an error corrector." The Examiner, on page 5 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message." Therefore, Maurill does not teach or suggest an error corrector as recited in claim 15. The Examiner goes on to combine Svoboda.

Svoboda, states "*after receiving a message, the message being delivered into a receiver communication unit through data communication means and stored in a storage unit, there is a password allocated to the sender, the password being allocated with respect to available information about an identity of the sender, and the password is delivered back to the transmitter communication unit as acknowledgement message and serves the sender as a key for obtaining an access to functions for modification and/or deleting a message stored in a communication unit of the receiver.*" (emphasis added) Therefore, Svoboda

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

teaches that any error correction is done at the receiving device. Because the correction recited in claim 15 is sent to a messaging server, the error corrector resides on the sending device.

Because Svoboda teaches editing at a receiving device, Svoboda actually teaches away from editing at the sending client device. Prior art that teaches away is a per se demonstration of lack of prima facie obviousness.² The Examiner correctly recognizes, on page 5 of the Office action, that neither Svoboda nor Maurille show an error corrector at the sending client device. The Examiner goes on to combine Golan.³

However, Golan discloses a system for correcting email messages and only works with emails that have special headers added to them at the initial transmission. Golan, para. 0036. "The presence of the header ... enables a correction module to locate the original message and to incorporate the original message as an attachment to the new, corrected email message." Because the present invention is used for instant messages and not emails and because the present invention does not use special headers, Golan would be inoperable with the present invention and can not suggest, alone or in any combination with the other cited references, the presently claimed invention.

Claims 16-20 depend from claim 15 and are therefore believed to be patentable for at least the same reason as discussed above for claim 15.

Claim 21:

Independent claim 21 recites, *inter alia*:

² See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

³ Applicants make no statement as to whether such a combination is even proper.

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

an error corrector, communicatively **coupled to the instant message manager**, for receiving a message correction specification and a message identifier (ID) **from an originating client system**, correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system, and sending the corrected message and the message ID to a recipient client system. **(Emphasis added).**

Claim 21 recites "an error corrector." The Examiner, on page 4 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message." Therefore Maurill does not teach or suggest an error corrector as recited in claim 21. The Examiner goes on to combine Svoboda.

As stated above, Svoboda discloses all error correcting function occurring at the **receiving** client device side. Claim 21 however, recites an error corrector being located at an instant message manager. Therefore, Svoboda, by teaching error correction at the receiving device actually *teaches away from* the present invention. Prior art that teaches away is a per se demonstration of lack of prima facie obviousness.⁴ The Examiner correctly recognizes, on page 5 of the Office action, that neither Svoboda nor Maurille show an error corrector at the sending client device. The Examiner goes on to combine Golan.⁵

However, as the Examiner concludes on page 6 of the Office Action, Golan teaches corrections at the sending device and **not at a messaging manager**. In addition, Golan discloses a system for correcting email messages and only works with emails that have special headers added to them at the initial transmission. Golan, para. 0036. "The presence of the header ... enables a correction module to locate the original message and to incorporate the original message as an attachment to the new, corrected email message." Because the present invention

⁴ See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

⁵ Applicants make no statement as to whether such a combination is even proper.

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

is used for instant messages and not emails and because the present invention does not use special headers, Golan would be inoperable with the present invention.

Claims 22-24 depend from claim 21 and are therefore believed to be patentable for at least the same reason as discussed above with respect to claim 21.

Claim 25:

Claim 25 recites, *inter alia*:

a messaging server, communicatively coupled to the at least one originating client system, for receiving a message correction specification and a message identifier (ID) from the at least one originating client system, correcting a message with a corresponding message ID if a message with a corresponding message ID has not previously been sent to a recipient client system, and sending the corrected message and the message ID to the recipient client system

The Examiner, on page 5 of the Office Action states that "Maurille does not show accepting a correction to a previously sent message" and, therefore, cannot show "*a messaging server... for receiving a message correction specification ... from the at least one originating client system*"

As stated above, Svoboda discloses all error correcting function occurring at the **receiving** client device side. Claim 25 however, recites an error corrector being located at an instant message **manager**. Therefore, Svoboda, by teaching error correction at the receiving device actually *teaches away from* the present invention. Prior art that teaches away is a per se demonstration of lack of prima facie obviousness.⁶ The Examiner correctly recognizes, on page 5 of the Office action, that neither Svoboda nor Maurille show an error corrector at the sending

⁶ See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

client device. The Examiner goes on to combine Golan.⁷

However, as the Examiner states on page 6 of the Office Action Golan teaches corrections at the sending device and **not at a messaging manager**. In addition, Golan discloses a system for correcting email messages and only works with emails that have special headers added to them at the initial transmission. Golan, para. 0036. "The presence of the header ... enables a correction module to locate the original message and to incorporate the original message as an attachment to the new, corrected email message." Because the present invention is used for instant messages and not emails and because the present invention does not use special headers, Golan would be inoperable with the present invention.

Claims 26 and 27 depend from claim 25 and are therefore believed to be patentable for at least the same reason as discussed above with respect to claim 25.

Accordingly, in view of the amendments and remarks above, since neither Maurille, Svoboda, Golan, nor any combination of the three cited references, teaches, anticipates, or suggests, the presently claimed invention, Applicant believes that the rejection of claims 15, 21, 24, and 25 under 35 U.S.C. 103(a) has been overcome. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 15, 21, 24, and 25. The Examiner should withdraw the rejection of these claims.

⁷ Applicants make no statement as to whether such a combination is even proper.

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

(5) Claim Rejections - 35 USC § 103 Svoboda in view of Lewis et al.

The Examiner rejected Claims 12 and 39 under 35 U.S.C. 103(a) as being unpatentable over Svoboda (U.S. Patent No. 6,597,771) in view of Lewis et al. (U.S. Patent No. 6,611,802)

In the section entitled "Rejection under 35 U.S.C. § 102 Svoboda" above, the deficiencies of the prior-art system disclosed in the Svoboda reference were discussed with respect to claims 11 and 38. Claims 12 and 39 depend directly from claims 11 and 38, respectively. As discussed above, independent claims 11 and 38 distinguish over Svoboda. Further, in view of the discussion above, it should be clear that Svoboda does not teach, anticipate, or suggest, the presently claimed invention, as recited for claims 11 and 38. For example, Svoboda discloses messages that are sent to a receiving client device and then deposited in a storage unit. Svoboda, col. 2, lines 50-62. The invention of Svoboda allows a user of the sending device to cause the message in the storage unit to be edited or deleted. Svoboda, col. 2, lines 24-31. Importantly, however, Svoboda is completely silent on "*activating an alert to notify a user of an update.*" In fact, Svoboda specifically states that the "invention allows the sender to change or delete the message **without bothering the addressee** with an invalid message." Svoboda, col. 2, lines 31-33. Therefore, Svoboda actually and expressly *teaches away* from "*activating an alert to notify a user of an update,*" as recited in claims 11 and 38 of the instant application. Additionally, Svoboda is silent on a "conversation log" and is therefore silent on the step of "*updating a conversation log,*" as recited in claims 11 and 38 of the instant application. Additionally, note that Svoboda's messaging is directly between a sender device and a receiver device, without an intermediary messaging server involved in the error correction. On the other hand, claims 11 and 38 recite the messaging server as an integral component of the sending of the message correction specification and the message identifier ID that is received by the receiver

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

device. Therefore, it should be clear that Svoboda does not teach, anticipate, or suggest, the presently claimed invention, as recited for claims 11 and 38. Since dependent claims contain all the limitations of the independent claims, claims 12 and 39 also distinguish over Svoboda, as well.

The Examiner combined Lewis with Svoboda to make obvious the feature of displaying highlighted corrected text in the Svoboda system. However, as the Examiner points out, Lewis discusses a method and system for proofreading and correcting dictated text. The reviewing of the document can include highlighting each word in the electronic document corresponding to the marked textual error marked in the marking step. It should be clear that Lewis does not teach or suggest an instant messaging system. Lewis does not show any messaging between a sender and a receiver. There clearly is no messaging server in Lewis. Therefore, Lewis does not teach or suggest the presently claimed features as recited for claims 11 and 38, and respectively for dependent claims 12 and 39.

Neither Svoboda, Lewis, nor any combination thereof, teaches, anticipates, or suggests the presently claimed invention as recited for dependent claims 12 and 39. For example, there is no teaching or suggestion of "activating an alert to notify a user of an update," as recited in claims 11 and 38 of the instant application, from which claims 12 and 39 depend. Svoboda actually teaches away from this claimed feature recited for the instant claims 12 and 39. Additionally, both cited references are silent as to a "conversation log" and therefore are silent on the claimed "*updating a conversation log*," as recited in claims 11 and 38 of the instant application. Additionally, neither reference teaches or suggests the messaging server being involved in the error correction, as presently claimed.

Accordingly, the Applicant asserts that Svoboda, Lewis, or any combination of the cited references, does not teach, anticipate, or suggest, the

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

presently claimed invention, as recited for dependent claims 12 and 39. The Applicant respectfully requests that the Examiner withdraw the rejection of claims 12 and 39.

Conclusion

The foregoing is submitted as full and complete response to the Official Action mailed December 1, 2005, and it is submitted that Claims 1-39 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of Claims 1-39 is earnestly solicited.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Applicant acknowledges the continuing duty of candor and good faith to disclose information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and the attorneys.

Additionally, a petition for a one month extension of time to file this Response has been attached to this Response. The Commissioner is hereby authorized to charge the extension fee for response of (\$120), or if this fee amount is insufficient, then the Commissioner is authorized to charge the

Appl. No. 10/042,668
Amdt. dated 03-02-2006
Reply to the Office Action of 12/01/2005

appropriate fee amount to prevent this application from becoming abandoned, to Deposit Account **50-1556**.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, or that in any way it would help expedite the prosecution of the patent application, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account **50-1556**.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

Respectfully submitted,

Date: March 2, 2006

By: 

Jose Gutman
Reg. No. 35,171

FLEIT, KAIN, GIBBONS, GUTMAN
BONGINI & BIANCO P.L.
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Tel (561) 989-9811
Fax (561) 989-9812